



Paper No. 19

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In re Application of
Weinrich et al.
Application No. 08/785,559
Filed: 17 January, 1997
Attorney Docket No. 9276.2

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ON PETITION

This is a decision on the renewed petition, filed on 11 August, 2000, to withdraw the holding of abandonment for the above-identified application.

The petition is again **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition to Withdraw the Holding of Abandonment" This is not a final agency decision.

This application became abandoned on 1 May, 1999 for failure to file a timely response to the non-final Office action mailed on 30 October, 1998, which set a three (3) month shortened statutory period for reply. No extensions of the time for reply in accordance with 37 CFR 1.136(a) were obtained. The filing of the instant petition precedes the mailing of Notice of Abandonment. The petition filed under 37 CFR 1.10 on 16 June, 1999, was dismissed in a decision mailed on 31 May, 2000.

On 1 May, 1999, petitioner filed (a) a petition for a three (3) month time extension, (b) an amendment, (c) a revocation and power of attorney, (d) a substitute specification, (e) a redlined specification, and (f) a microfiche appendix. Although the correspondence was received after the application had become abandoned, petitioner asserts, however, that the above items were timely filed by "Express Mail Post Office to Addressee" on 30 April, 1999.

Petitioner asserts that a timely response was filed via USPS "Express Mail Post

Office to Addressee" service. In support, petitioner provides in its renewed petition, *inter alia*, a declaration of facts by Josephine B. Hardy, in which Ms. Hardy states that she deposited a reply to the Office action mailed on 30 October, 1998, in USPS "Express Mail Post Office to Addressee" service on 30 April, 1999. Petitioner states that a copy of the Express Mail mailing label was not received at the time of deposit, and that no copy has since been received.

APPLICABLE LAW

37 CFR 1.10(a) states:

Any correspondence received by the Patent and Trademark Office that was delivered by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) will be considered filed in the Office on the date of deposit with the USPS. The date of deposit with the USPS is shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation. *If the USPS deposit date cannot be determined, the correspondence will be accorded the Office receipt date as the filing date.* (emphasis added)

37 CFR 1.10(d) states:

Where correspondence is deposited with the USPS and received by the Patent and Trademark Office and it is asserted that the "date-in" date on the "Express Mail Mailing" label was incorrectly entered or omitted, the person filing the correspondence may petition the Commissioner to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS. A grantable petition under 37 CFR 1.10(d) requires:

(1) that the petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;

(2) the number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail";

(3) the petition includes a showing which establishes, to the satisfaction of the Commissioner, that the requested filing date was the date the correspondence was deposited in the Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph *must* be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the "Express

Mail Post Office to Addressee" service of the USPS.

37 CFR 1.8(b) states:

In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

(1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;

(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate, and

(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

MPEP 503 states:

A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the USPTO of all of the items listed thereon on the date stamped thereon by the USPTO.

OPINION

Petitioner should note that abandonment takes place by operation of law for failure to timely submit a proper reply to an Office action.¹ As such, since the latest date on which a timely response to the Office action mailed on 30 August, 1998, could be submitted was 30 April, 1999, abandonment occurred at midnight on 1 May, 1999.

The petition must be again dismissed because petitioner has not provided a sufficient showing of evidence to establish timely receipt in the Office of petitioner's response to the Office action mailed on 30 October, 1998. Petitioners' statement that "since there is no question" that petitioner's response to the Office action mailed on 30 October, 1998, "was received no later than May 1, 1999, it

¹ MPEP 711.03(c); See Lorenz v. Finkl, 333 F.2d 885-889-90, 142 USPQ 26, 299-30 (CCPA 1964); Krahn v. Comm'r, 15 USPQ2d 1823, 1824 (E.D. Va. 1990); In re Application of Fischer, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

must have been submitted to the USPS no later than April 30, 1999" is not well taken. Rather, it is petitioner's burden to supply, under the rules of practice, sufficient evidence to establish that the reply asserted to have been deposited within the U.S. Postal Service on 30 April, 1999, was actually entrusted to the U.S. Postal Service on that date.²

As explained in the decision mailed on 31 May, 2000, 37 CFR 1.10(a) requires a showing of the "date-in" on either the "Express Mail" mailing label or other official documentation from the USPS. As the standard practice of the USPS is to provide a copy of the "Express Mail" mailing label showing the "date-in" at the time of deposit, this situation is highly unusual. Petitioner should have requested a copy of the "Express Mail" mailing label at the time of deposit. Moreover, in the renewed petition, petitioner still has not shown, despite the fact that over a year has elapsed between the mailing of the correspondence in question and the date that the present renewed petition was filed, that any attempts have been made to obtain a copy of the mailing label for the correspondence in question from USPS, or any other official statement from the USPS. Petitioner should obtain written confirmation from the USPS that the correspondence in question was deposited in Express Mail service on the requested filing date prior to the last scheduled pickup of that day. Petitioner is again reminded that any evidence submitted to corroborate a petition under 37 CFR 1.10(e), other than an official statement by the USPS, must have come into being after deposit and within one business day of the alleged deposit of the correspondence in Express Mail. As such, the declarations of Josephine B. Hardy and Francis E. Morris, both dated 11 August, 2000, are insufficient to show deposit of the correspondence in question in Express Mail on the requested filing date.

Additionally, petitioner could have utilized the Certificate of Mailing procedure described at 37 CFR 1.8. Had petitioner properly followed the aforementioned procedure, petitioner could have avoided the predicament which has now arisen. It is petitioner's burden to supply, under the rules of practice, sufficient evidence to establish that the reply asserted to have been deposited with the U.S. Postal Service on 30 April, 1998, was actually entrusted to the U.S. Postal Service on that date.³ At best, the showing of record reveals petitioner's intent to timely reply to the Office action. Petitioner's itemized postcard reply, bearing an Office date stamp of 1 May, 1999, is also insufficient to show receipt of the correspondence in the Office on a date other than 1 May, 1999.

² See Krahn v. Commissioner, 15 USPQ2d 1823, 1825, (E.D. Va 1990); see also MPEP 711.03(c)(III)(C)(2).

³ See Krahn v. Comm'r, 15 USPQ2d 1823, 1825 (D.C. E. D. Va. 1990).

In regards to the "MAIL DATE CANCELED" legend stamped across the date stamp of 1 May, 1999, on the copy of the postcard reply submitted with the initial petition, upon further review it appears that "MAIL DATE CANCELED" was stamped by the Office of Initial Patent Examination upon receipt of the initial petition to avoid confusion with the date stamp of 16 June, 1999, which is the date of receipt of the petition. Petitioner has not explained, however, why the petition and affidavit are dated 17 June, 1999, although they have been stamped as received on 16 June, 1999, by the U.S. Patent and Trademark Office.

As petitioner has not provided sufficient evidence of timely filing of the request for a three month time extension and amendment, the petition is dismissed and this application remains abandoned. Petitioner is reminded that while an applicant may delay action until the end of the time period for reply, the applicant must assume the risk attendant to such delay.⁴

Accordingly, this application remains abandoned.

ALTERNATE VENUE

Petitioner is strongly advised to consider filing a renewed petition under 37 CFR 1.137(b), which now provides that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

The filing of a petition under the unintentional standard cannot be intentionally

⁴Ex parte Warren, 1901 Dec. Comm'r Pat. 137 (Comm'r Pat. 1901).

delayed and therefore should be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

A copy of the form for filing a petition under 37 CFR 1.137(b) to revive an application unintentionally abandoned is enclosed herewith for petitioner's convenience.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner of Patents and Trademarks
Box DAC
Washington, D.C. 20231

By FAX: (703)308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite CP4-3C23
2201 South Clark Place
Arlington, VA 22202

Telephone inquiries concerning this matter may be directed to Petitions Attorney Douglas I. Wood at (703)308-6918.



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Enclosure: Form PTO/SB/64